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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,346	06/21/2001	Dwight Randall Smith	PF02258NA	5638

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EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT	PAPER NUMBER
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2687

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,346

Applicant(s)

SMITH ET AL.

Examiner

Eliseo Ramos-Feliciano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/4/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The references listed in the Information Disclosure Statement filed on June 4, 2004 have been considered by the examiner (see attached PTO-1449 form).

Drawings

2. The drawings were received on August 24, 2004. These drawings are acceptable.
3. Previous objection to the drawing have been withdrawn in view of the amendment filed August 24, 2004.

Claim Rejections - 35 USC § 112

4. Previous 35 USC 112, second paragraph, rejection have been withdrawn in view of the amendment filed August 24, 2004.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1, 5-12, and 16-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsou et al. (US Patent Application Publication Number US2002/0184089A1) in view of Heath et al. (US Patent Number 6,636,872).

Regarding claim 1, Tsou et al. discloses an apparatus for providing Instant Messaging (IM) services in a wireless communication system (300), as shown in Figure 3; see the abstract.

The invention includes:

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an IM data storage device (204, 316) for storing new presence information (first IM contact data) associated with an IM client (212),

an IM server (210) to access the IM data storage device (214, 316) and retrieve the presence information (first IM contact data) associated with the IM client (212),

an IM access portal (302) in operable communication with the IM server (210) and for accessing previous presence information (second IM contact data) associated with the IM client (212) and transmitted to a wireless device (308, 208) of the IM client (212) during a prior wireless connection. The IM access portal (302) is further configured to transmit an update of the presence information to the wireless device (308, 208); the update being based on the new presence information. See Figure 3 and particularly paragraphs 0002-0003, 0013, 0041-0047, 0050-0052.

Such updated presence information can be characterized as “difference IM contact data”. However, Tsou et al. fails to particularly disclose that the updated or difference IM contact data is produced from a comparison of the first IM contact data and the second IM contact data.

Heath et al. teaches a simple method for transmission of updated data, file, or information from a server to a client. The existing version of the data/file/information is compared with the updated data/file/information. The differences therebetween are determined and transmitted. Only the difference, i.e., those portions not found in the existing version, are transmitted. (See column 1, lines 45-50). Therefore, the updated data transmission consist of difference data only. The motivation taught by Heath et al. is that generally an update consists of changing only small portions of the original data (column 1, lines 35-36), and to better compress the update to a fraction of the actual size (column 1, line 44).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to compare the first IM contact data with the second IM contact data, and transmit only the differences, those portions not found in the original data (“difference IM contact data”), because generally an update consists of changing only small portions of the original data, and for achieving a better compression technique, as suggested by Heath et al.

As to **claim 12**, it is the corresponding method claim of apparatus *claim 1*; therefore, it is rejected for the same reasons set forth above.

Regarding **claims 5-6 and 16-17**, Tsou et al. and Heath et al. disclose everything claimed as applied above (see *claims 1 and 12*). In addition, Tsou et al. teaches that the transmitted data is just an update and Heath et al. teaches that generally an update consists of changing only small portions of the original data (column 1, lines 35-36 of Heath et al.). Therefore, one can reasonably conclude that the difference (updated) IM contact data has “about less” addressing data than either the first IM contact data or the second IM contact data as claimed.

Regarding **claim 7**, Tsou et al. and Heath et al. disclose everything claimed as applied above (see *claim 1*). In addition, Tsou et al. teaches that the invention further includes an IM access portal storage device (310, 312) for storing the second IM contact data. See Figure 3 and citations above.

Regarding **claims 8, 10-11, 18 and 20-21**, Tsou et al. and Heath et al. disclose everything claimed as applied above (see *claim 1 and 12*). In addition, Tsou et al. teaches that the wireless device can be any portable wireless device. For example: cellular telephone, mobile PDA, or mobile radio. See Figure 1, paragraph 0002, 0004, etc.

With respect to **claims 9 and 19**, Tsou et al. and Heath et al. disclose everything claimed as applied above (see *claims 1 and 12*). However, they fail to particularly disclose a two-way pager. But, as explained above, Tsou et al. teaches that the wireless device can be any portable wireless device. The examiner contends that such teaching suggests a two-way pager as claimed. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the subject invention on a two-way pager for the advantage of better portability and wide availability, since Tsou et al. already suggests a portable wireless device.

7. **Claims 2-4 and 13-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsou et al. and Heath et al. as applied to *claims 1 and 12* above, and further in view of Birkler et al. (US Patent Application Publication Number US2002/0129103A1).

Regarding **claims 2-4 and 13-15**, Tsou et al. and Heath et al. disclose everything claimed as applied above (see *claims 1 and 12*). However, they fail to particularly disclose when to perform the comparison as defined by applicant.

Birkler et al. teaches a simple method for updating IM presence information (IM contact data) from a server to a client. The original version is compared with the new version when the client establishes connection. If they match, meaning they are the same, no update is needed, and, therefore, not provided; then a delay (predetermined interval) is established. If they do not match, meaning they are not the same, the update is immediately provided. In this way, the update is provided if the IM presence information (IM contact data) is altered. See paragraphs 0020-0023, abstract, and Figure 4. Therefore, Birkler et al. teaches to perform the update only when needed, in order to save system resources.

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to perform the subject comparison when the wireless device initially establishes connection, after a predetermined interval, and/or if the IM contact data is altered, because it is more efficient to be performed when it is needed and suggested by Birkler et al., in order to save system resources.

Response to Amendment

8. The declaration filed on August 24, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Tsou et al. or Birkler et al. reference.

9. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Tsou et al. or Birkler et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The evidence submitted fails to show the following, the insufficiency not limited to these examples: ① regarding claim 1, the evidence fails to show “an IM access portal in operable communication with said IM server and configured to access second IM contact data associated with said IM client and transmitted to a wireless device of said IM client during a prior wireless connection”; ② regarding claim 2, the evidence fails to show “wherein said access portal is configured to perform said comparison of said first IM contact data and said second IM contact data when the wireless device initially establishes a wireless connection with said IM access portal”. In establishing conception a party must show possession of every feature recited in the

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count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception – MPEP 2138.04.

10. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Tsou et al. or Birkler et al. reference to either a constructive reduction to practice or an actual reduction to practice.

The evidence submitted shows no account for the entire period during which diligence is required. The entire period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. Applicant must account for the entire period during which diligence is required – MPEP 2138.06.

Response to Arguments

11. Applicant's arguments filed August 24, 2004 have been fully considered but they are not persuasive.

Applicant's arguments (pages 10 and 11) concerning the filing of a declaration under 37 CFR 1.131 have been considered and are addressed above.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 703-305-0078. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid, can be reached on (703) 306-3016. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ERF/erf
November 16, 2004

ELISEO RAMOS-FELICIANO
PATENT EXAMINER




11/24/04
LESTER G. KINCAID
PRIMARY EXAMINER